

## REMARKS/ARGUMENTS

Claims 1-11, 15-25, and 29-39 have been elected.

The applicant has studied the Office Action dated October 14, 2004 and the Advisory Action mailed February 7, 2005 and believes the application is in condition for allowance. Reconsideration and reexamination are respectfully requested.

Claims 1-11, 15-25, and 29-39 have been rejected as being unpatentable (35 U.S.C. 103(a)) by Courter et al. (hereinafter the Courter reference). This rejection is respectfully traversed.

The applicant thanks Examiners Shah and Hillery for the courtesy of an interview conducted by telephone on February 28, 2005. In this interview, the Primary Examiner Shah recommended that the claims be amended to clarify recited operations should it be determined that one or more words do not form a contact phrase. Examiner Shah stated that if the claims were clarified in this manner, the claims would, depending upon the particular language used, likely be patentably distinguished over the art of record. However, Examiner Shah indicated that a further search might be taken.

The applicant also thanks Examiner Hillery for the courtesy of an interview conducted by telephone on March 1, 2005, in which Examiner Hillery confirmed that the due date for a response was February 7, 2005, the mailing date of the advisory action, and that any extensions would be calculated from the February 7, 2005 date.

Claim 1, as amended, requires, *inter alia*, "... scanning and parsing words in the text; for each set of one or more scanned and parsed words, determining whether one or more words form a scanned contact phrase providing information to identify or address a person or entity ..." The Examiner has cited no teaching or suggestion in the Courter reference of a method comprising "scanning and parsing words in the text; for each set of one or more scanned and parsed words, determining whether one or more words form a scanned contact phrase providing information to identify or address a person or entity" as required by claim 1.

An electronic text may contain many different kinds of words. In an electronic text, these words in various combinations may form various parts of speech including nouns, verbs, adjectives, articles, prepositions etc. or various parts of a document including phrases, sentences, paragraphs, messages, titles, tables, footnotes etc. or many others types of text. Some of these words or combinations of words may be recognized as forming a contact phrase. Some of these words or combinations of words may be recognized as forming text *other* than a contact phrase. To distinguish between words which form a contact phrase and words which form text *other* than a contact phrase, claim 1 recites "...determining whether one or more words form a scanned contact phrase providing information to identify or address a person or entity ..."

It is noted that the Examiner has cited page 407 of the Counter reference as describing entering an e-mail address in a "text box." It is believed that the referenced "text box" is an input field labeled "E-mail" of an Outlook Contact form (see FIG. 18.1, page 403). As such, this input field is reserved for e-mail addresses. Hence, it is respectfully submitted that the Examiner's citations to the Counter reference do not describe a method which includes "... scanning and parsing words in the text; for each set of one or more scanned and parsed words, determining whether one or more words form a scanned contact phrase providing information to identify or address a person or entity ..." as required by claim 1. Instead, all text entered by the user into the "E-mail" input field of the Outlook Contact form cited by the Examiner appears to be treated by the Outlook program as an e-mail address without any prior determination as such. It is believed that the e-mail address entered into the "E-mail" input field is examined to determine if the format of the entered e-mail address matches a predetermined format. However, the Examiner has cited no teaching or suggestion that a determination is made as to whether the entered text is an e-mail address or contact phrase.

Indeed, it is the Examiner's position merely that the Outlook program "determines if the input [into the "E-mail" input field of the Outlook Contact form] is a valid contact phrase." Thus, the Examiner does not contend that the Outlook program determines whether the input is a contact phrase, merely whether the inputted contact phrase is valid or invalid.

Still further, the Examiner concedes that “Courter et al. do not explicitly teach checking text in an electronic document ... .” Recognizing the deficiencies of the Examiner’s citations, the Examiner has taken the position that “it would have been obvious ... to be motivated to ... [check text in an electronic document] since the invention of Courter et al. searches the header of an e-mail message to ensure that the user is sending the message to the desired recipient(s).” The applicants strongly disagree.

Again, it is believed that all text entered by the user into the recipient field of an Outlook email message is treated by the Outlook program as an e-mail address without any prior determination as such. It is believed that the e-mail address entered into the recipient field is merely examined to determine whether the entered address is valid or whether the format of the entered e-mail address matches a predetermined format. However, the Examiner has cited no teaching, suggestion or motivation to make a determination as to whether the entered text is an e-mail address or contact phrase in the first place.

Claim 1 also explicitly requires “upon determining that one or more words do not form a scanned contact phrase, performing said scanned contact phrase determining with respect to other words of said text.” The Examiner has cited no teaching or suggestion in the Courter reference of a method comprising “upon determining that one or more words do not form a scanned contact phrase, performing said scanned contact phrase determining with respect to other words of said text” as explicitly required by claim 1. Instead, as noted above, all text entered by the user into the “E-mail” input field of the Outlook Contact form cited by the Examiner appears to be treated by the Outlook program as an e-mail address without any prior determination as such.

Independent claims 15 and 29 may be distinguished in an analogous fashion.

Claims 2-11 depend either directly or indirectly from claim 1; claims 16-25 depend either directly or indirectly from claim 15; and claims 30-39 depend either directly or indirectly from claim 29. Accordingly, the rejection of these claims is improper for the reasons given above. Moreover, these dependent claims include additional limitations, which in combination with the base and intervening claims from which they depend provide still further grounds of patentability

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Reply to Office action of October 14, 2004

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over the cited art. For example, dependent claim 2 further provides that in the method of claim 1, the “contact phrases comprise one of a name, phone number, street address, e-mail address, and URL” and the method of claim 1 further comprises “spell checking words determined not to form a scanned contact phrase.”

The Examiner has made various comments concerning the anticipation or obviousness of certain features of the present inventions. Applicant respectfully disagrees. Applicant has addressed those comments directly herein above or the Examiner’s comments are deemed moot in view of the above response.

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Conclusion

For all the above reasons, Applicant submits that the pending claims 1-11, 15-25 and 29-39 are patentable over the art of record. Applicants have not added any claims. Nonetheless, should any additional fees be required, please charge Deposit Account No. 50-5085.

The attorney of record invites the Examiner to contact him at (310) 553-7977 if the Examiner believes such contact would advance the prosecution of the case.

By:



Dated: March 4, 2005

William K. Konrad

Registration No. 28,868

Please direct all correspondences to:

David Victor

Konrad Raynes & Victor, LLP  
315 South Beverly Drive, Ste. 210  
Beverly Hills, CA 90212  
Tel: 310-553-7977  
Fax: 310-556-7984